

THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Wilhelmus C. M. Lohbeck)	Conf. No.:	8251
)		
Serial No.:	10/563,505)	Art Unit:	3672
)		
Filed:	December 4, 2003)	Examiner:	Brad Harcourt
)		
For:	Method of Expanding a Bell of a)	June 13, 2008	
	Monodiameter Well)		

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Pre-Appeal Brief Request for Review

Dear Sir:

In response to the Final Office Action dated February 28, 2008, and the Advisory Action dated June 3, 2008, for which the Applicant thanks the Examiner, Attorney for Applicant in the above-identified Application requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

At the time the Final Office Action issued, claims 1-12 were pending. For the sake of brevity, only independent claim 1 and dependent claim 10 reproduced below, as those claims are sufficient for consideration of the question currently at issue.

The listing of claim 1 below shows the after-final amendment filed previously but not entered on the grounds that it would require further search.

Claims 1 and 10

1. (Showing previously requested after-final amendment) A method of expanding a tubular element having a first portion to be expanded to a first inner diameter and a second portion to be expanded to a second inner diameter larger than the first inner diameter, comprising:

- a) arranging an expandable sleeve of selected wall thickness in said second portion;
- b) positioning an expander in the tubular element;
- c) operating the expander so as to expand said first portion to the first inner diameter, and operating the expander so as to expand the sleeve to an inner diameter substantially equal to the second inner diameter minus double the wall thickness of the sleeve; and
- d) retrieving the sleeve, including the portion of the sleeve that was expanded in step c), from the tubular element through the first portion, thereby reducing the diameter of the sleeve.

10. The method of claim 4, wherein step d) comprises moving the sleeve into said first tubular element portion thereby radially contracting the sleeve whereby said members are subjected to reverse bending.

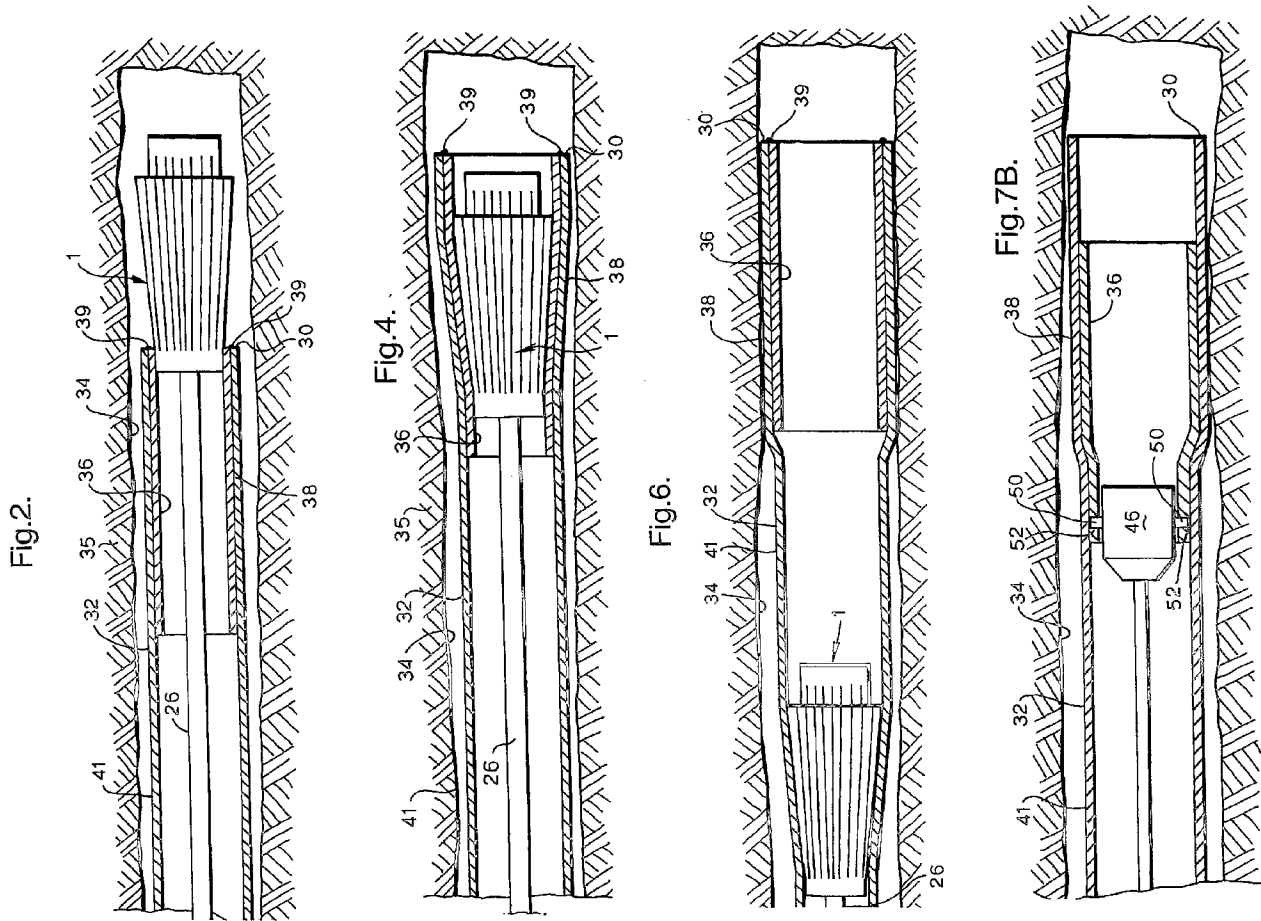
Remarks

Claims 1-3 and 12 are currently rejected as obvious over the combination of Kendziora (WO 03/029607) with Harrall (US 20050011650) and claims 4-7 as obvious over the combination of Kendziora with Harrall and Schetky (US 6772836). Claims 8-11 would be allowable if re-written independent form, but Applicant has deferred placing claims 8-11 in condition for allowance.

The sole question at issue is whether the previously submitted after-final amendment should have been entered. Despite the fact that it clearly places the claims in condition for allowance, the Examiner refused to enter it on the grounds that it would require further search. Applicant submits that this is not the case.

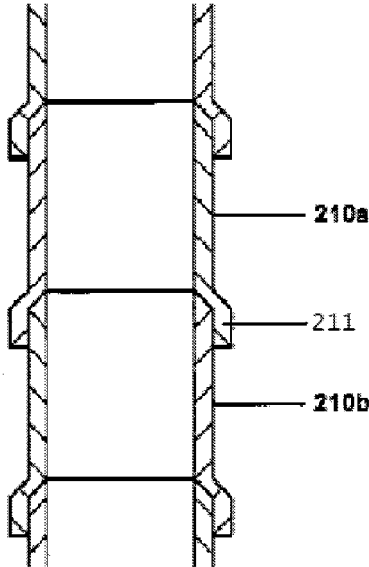
In the after-final response submitted previously, Applicant attempted to amend the claims to explicitly recite in claim 1 a feature that was present in the original dependent claims.

To facilitate an understanding of the issue, the following figures and presentation of the claim are provided:



Without the requested amendment, claim 1 reads: A method of expanding a tubular element 32 having a first portion 41 to be expanded to a first inner diameter and a second portion 38 to be expanded to a second inner diameter larger than the first inner diameter, comprising: a) arranging an expandable sleeve 36 of selected wall thickness in said second portion (FIG 2); b) positioning an expander 1 in the tubular element; c) operating the expander 1 so as to expand said first portion 41 to the first inner diameter (FIG 6), and operating the expander so as to expand the sleeve 36 to an inner diameter substantially equal to the second inner diameter minus double the wall thickness of the sleeve (FIG 4); and d) retrieving the sleeve 36 from the tubular element 32 (FIG 7B).

As taught in the present specification, sleeve 36 can be retrieved through the smaller-diameter first portion because it is provided with devices that allow it to be relatively easily expanded and collapsed.



In citing Kendziora against claim 1, the Examiner uses the figure at left, and states that it discloses expanding a tubular comprising a first tubing section 210a, second tubing section 211; and expandable sleeve 210b. The Examiner further states that first and second tubing sections 210a and 211 are expanded, sleeve 210 b is placed adjacent to second tubing section 211; sleeve 210 b is expanded to the same diameter of tubing section 210a, and second tubing section 211 is expanded to a diameter that is the sum of first section 210a and twice the wall thickness of sleeve 210b.

As recognized by the Examiner, Kendziora makes no mention of removing any of the tubing sections that are thus deployed. Applicant points out that this is because Kendziora relates to a monodiameter casing. As is well known, casing not typically removed from the borehole. In fact, Kendziora teaches that the expandable tubular members can be cemented in place.

Even if Kendziora did not relate to casing, and did not teach cementing the tubulars in place, however, Kendziora still could not support the present obviousness rejection. In the system taught by Kendziora there is simply no way to retrieve any tubular section from the well, as no expanded section will fit through the section above it.

Nonetheless, in support of the rejection, the Examiner has stated that, “Harrell discloses expanding a portion of a sleeve 565 and removing an unexpanded portion of the sleeve through the expanded portion, which could be combined with the expandable system of Kendziora in view of Harrell by someone having ordinary skill in the art to remove a bottom unexpanded portion of the sleeve.” (emphasis added).

Applicant respectfully submits that such a reading of the present claims is illogical. Applicant’s claim 1 reads, in paraphrased form: expanding the sleeve and...retrieving the sleeve. The most logical interpretation of the language of claim 1, which is the interpretation intended by the Applicant, is that the item that is retrieved includes at least the same item that was expanded,

i.e. the sleeve. The Examiner's assertion that the claim should encompass a technique that includes "expanding a portion of a sleeve and removing an *unexpanded* portion of the sleeve through the expanded portion" simply does not comport with the plain language of the claim.

When it became apparent that the Examiner nonetheless intended to maintain this interpretation of the claim, Applicant attempted, in an after-final amendment, to include clarifying language in claim 1. Specifically, the passage "retrieving the sleeve from the tubular element" was amended to read "retrieving the sleeve, including the portion of the sleeve that was expanded in step c), from the tubular element through the first portion, thereby reducing the diameter of the sleeve."

The Examiner has refused to enter this amendment on the grounds that it would require further searching. This is not true, however, as 1) the amendment is merely the articulation of the logical meaning of the original claims and 2) the concept recited in the proposed amendment was present in original claim 10 (see p. 2 above) and should already have been searched.

Thus, Applicant submits that the claims should be allowed without the amendment because, when they are read logically, they are distinguishable over the references.

Applicant alternatively submits that, if it is determined that an amendment is required to place the claims in condition for allowance, that an amendment should be entered, as the features recited in the amendment were present in the original claims and therefore do not require further searching.¹

If the Pre-Appeal Review panel has any questions or comments regarding the case, they are respectfully encouraged to telephone the undersigned at (713) 241-1041.

Respectfully submitted,
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¹ If necessary, Applicant would accept any of several variations on the proposed amendment, including "retrieving the sleeve, including the portion of the sleeve that was expanded in step c), from the tubular element," "retrieving the expanded sleeve, from the tubular element through the first portion," or "retrieving the sleeve, from the tubular element through the first portion, thereby radially contracting the sleeve."